

Serial No.: 10/686,510
Office Action Date: 08/05/2005

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Amendment Date: 10/19/2005

Amendments to the Drawings:

The attached drawing sheet includes revised Fig. 1. This sheet replaces the original drawing sheet (1/8).

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REMARKS/ARGUMENTS

This is in response to the Office Action issued on August 05, 2005 with claims 1-20 pending in the Application. By this response to the Office Action, new claim 21 has been added. Claims 1-21 remain in consideration.

Drawing Objections

The drawings were objected to because it was stated that boxes should be properly labeled. New drawing sheets are submitted herein, addressing the reasons for the objection. No new matter has been added by the corrected drawing sheets.

Double Patenting

Claims 1-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 11-12 of co-pending U.S. Patent Application No. 10/779,558.

Applicants are prepared to timely execute a terminal disclaimer to overcome the examiner's rejection.

Claim Rejections – 35 U.S.C. § 102

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Tabata*, et al. '570.

The examiner is likely well aware that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). And, "[a]bsence from the reference of any claimed element negates anticipation." *Row v. Dror*, 42 USPQ 2d 1550, 1553 (Fed. Cir. 1997) (quoting *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986)).

Applicant respectfully asserts that *Tabata*, et al. neither teaches nor discloses a method for controlling a shift from a first mode to a second mode in a

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multi-mode, electro-mechanical transmission as described in claim 1 of the instant invention, including especially the element of thereafter releasing an offgoing torque transfer device while controlling slip speed across the offgoing torque transfer device to substantially zero by adjusting motor torque.

Tabata, et al. describes executing an operation mode determining subroutine, for selecting one of nine operating modes. See, e.g. Col 13, lines 39-43, and Fig. 7, 8). A transmission shift control subroutine is described, with reference to Fig. 10. Time charts shown in Fig. 14 and 15, and described starting at Col 23, Line 61 provide description of various parameters during the 2-3 shift up action. However, there is no description of thereafter releasing an offgoing torque transfer device while controlling slip speed across the offgoing torque transfer device to substantially zero by adjusting motor torque, as claimed in claim 1 of the instant invention.

Furthermore, the instant invention of claim 1 describes a first mode operation characterized by simultaneous first torque transfer device applied and second torque transfer device released. Second mode operation is characterized by simultaneous first torque transfer device released and second torque transfer device applied.

In contradistinction to this element of claim 1, *Tabata*, et al. neither teaches nor describes first and second transfer modes as described hereinabove. Referring specifically to Fig. 8 and the accompanying description starting at Col. 13, Line 39, *Tabata*, et al. neither teaches nor describes a mode of operation analogous to the second mode of operation of the instant invention, wherein there is a simultaneous first torque transfer device released and second torque transfer device applied, with the engine "on".

In view of the above, i.e., applicant argues that *Tabata*, et al. neither teaches nor describes the mode of operation, nor the method for controlling shift from a first mode to a second mode, as taught by claim 1 of the instant invention. Applicant respectfully argues that *Tabata*, et al. fails to anticipate any claims of the instant invention, and particularly fails to anticipate claim 1, as described

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hereinabove.

Claims 13 and 18 are patentably distinguishable from the prior art cited thereagainst for the same reasons as set forth with regard to Claim 1, and are therefore allowable. Claims 2 – 12, 14-17, and 19-20 all depend from one of independent claims 1, 13, or 18, and claim additional limitations thereto, and are therefore allowable.

Therefore, applicant respectfully requests that any rejection of claims 1 – 20 based upon *Tabata*, et al. be withdrawn.

New Claim

Applicant respectfully submits new claim 21, which more particularly points out an element of patentable subject matter of the invention. New claim 21 is dependent upon now allowable claim 1, and comprises the method for controlling a shift from a first mode to a second mode in a multi-mode, electro-mechanical transmission including, wherein the at least one motor comprises two electrical motors.

Consideration of new claim 21 is respectfully requested.

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Conclusion

Based upon all of the above, it is respectfully submitted that pending claims 1-21 are in condition for allowance and that same be allowed to proceed to issue. If the Examiner has any questions regarding the contents of the present response, Applicants' attorney may be contacted at the phone number appearing below during normal business hours.

Respectfully submitted,



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